

**REMARKS**

The claims have been amended to emphasize that the printing ink of the present invention is a hybrid energy curable solvent based printing ink, as stated in the title, and that the vehicle comprises solvent as indicated at page 18, line 15 et seq.

The rejections of claims 1-20 under 35 U.S.C. §103 over Ylitalo in view of either Knox or Tsuyoshi are respectfully traversed.

The Ylitalo reference relates to an ink-jet printing ink which has been specifically designed to overcome a specific problem, namely foaming when the ink contains a fluorinated surfactant. The ink must thus contain a fluorinated surfactant, colorant and a vehicle. The composition can also contain a plethora of other materials, all of which are optional. Twenty-one (21) categories of such optional materials are set forth in [0021]. Ylitalo teaches in [0080] that solvents, which may be aqueous or organic, when present, are chosen to provide desired physical properties such as viscosity, and the like. That [0080] paragraph also states "For radiation curable ink, the solvent component is desirably absent."

As the Examiner has acknowledged, Ylitalo fails to teach or suggest a composition in which any solvent-soluble resin can be present. The Supreme Court in *KSR*, and subsequent Federal Circuit cases have made it clear that there must be some reason to extract a teaching from a secondary reference and incorporate it into the relevant part of the primary reference. As the MPEP 2143 states "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." Since Ylitalo's composition may or may not contain an energy-curable material, there must be a valid reason here to select the

energy-curable material and then to extract some teaching from the secondary references and incorporate it into Ylitalo. While the Office Action proffers a reason, that “reason” is not tenable, as it is a retrospective construct lacking any basis.

Both of the Knox and Tsuyoshi references teach compositions which can contain a solvent-soluble resin. But that fact, standing alone, is not a reason to incorporate the solvent-soluble resin in a composition like Ylitalo which cures by a different mechanism, namely polymerization or cross-linking, thereby requiring the presence of a photoinitiator [0086], and which is preferably solvent-free [0080]. As is apparent, the proposed reason must be to correct a deficiency or provide a feature but there is nothing to suggest that the Ylitalo composition is deficient or lacks some feature. Not only is the proposed reason a retrospective construct, but it ignores the pertinent question of why one would incorporate a solvent-soluble resin in the radiation curable composition which Ylitalo teaches should not contain a solvent?

A reason to use something in one reference is not, *ipso facto*, a reason to use it in a completely different set of circumstances. If there was a reason to use the material in the different type of composition, that reason must be related to providing a characteristic which is either not present or inadequate, taking compatibility with composition into consideration. Neither is true here.

The reason set forth in the Office Action is based on characterizing Knox and Tsuyoshi as teaching an ink composition containing a solvent-soluble resin that provides a printing image with good adhesion. That characterization is wrong. A review of both references, including the passages in each identified in the Office Action,

has not revealed any teaching or suggestion that either composition provides good adhesion.

The Knox reference is even more deficient in that it does not even teach or suggest a printing ink. Most of Knox is concerned with the manner in which a metal pigment is prepared. It also indicates that a paste containing the pigment can be mixed with an organic binder medium (col. 6, lines 45-47), which binder can be a solvent-soluble resin (col. 6, lines 52-53), to form a product which is typically in a form such as a tablet, pellet, granule, flake, or spherical bead (col. 7, lines 8-9). The function of the solvent-soluble resin in this composition is to bind the metal pigment flakes together to prevent them from becoming airborne as dust (col. 7, lines 20-22). Nothing in this reference teaches any way to obtain an ink, much less an ink composition which provides a printed image with good adhesion.

The Tsuyoshi printing ink contains a Monascus pigment. This type of pigment maintains its integrity until it is quickly discolored on exposure to visible light and/or ultraviolet light (see, *inter alia*, the Abstract). Consulting a disclosure about a composition which is intended to be protected from exposure to visible or ultraviolet light during consideration of modifying a composition which is intended to be cured by the application of actinic radiation is illogical.

Prior rejections have been withdrawn because there was no valid reason for extracting a solvent-soluble resin from a secondary references and incorporating it into the energy curable composition of Ylitalo. In the current rejections, there is also no valid reason existent for extracting a solvent-soluble resin from the secondary references (or any other reference for that matter) and incorporating it into a energy

curable composition. It is respectfully submitted that the proposed combination is improper and any rejection based on them is untenable.

In view of the above amendment and remarks, applicant believes the pending application is in condition for allowance.

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